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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,288	03/29/2000	Masao Okada	862.C1871	7078

5514 7590 07/23/2007
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EXAMINER

D'AGOSTINO, PAUL ANTHONY

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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07/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Sp

Office Action Summary

Application No.

09/537,288

Applicant(s)

OKADA ET AL.

Examiner

Paul A. D'Agostino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/8/2006 and 10/3/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 19-26, 32 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 19-26, 32 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17, 19, 20, 21 - 26, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,913,019 to Attenberg (Attenberg) of record in view of U.S. Patent No. 6,369,908 to Frey et al. (Frey) of record.

In Reference to Claims 17, 25, 26, and 36

Attenberg discloses a sticker printing apparatus {A control method of a stick printing apparatus; A storage medium storing program codes; A printing apparatus} (Fig. 1 "photo kiosk" 10) for printing a desired sticker ("sticker sheet" Col. 5 Lines 26-27 and Fig. 5) by operating a touch panel ("touch display" Col. 4 Line 21) overlaid on a display screen ("monitor" 14 Col. 4 Line 21), comprising:

storage means {a storing step} ("CPU saves the captured image" Col. 8 Line 46 and "stored in memory 21a associated with CPU 21" Col. 7 Line 49) for storing a plurality of images ("image from camera 16" Col. 7 Lines 48 and "background image" Col. 8 Line 21) , which are to be parts for forming a sticker {an image to be printed} (Fig. 5 and "stickers" Col. 5 Line 22), as a plurality of logical layers ("user as one layer 'layer 1' and backdrop color/background image as another layer 'layer 2'" Col. 8 Lines 31-32)

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which overlie each other in a fixed order ("Once the background image is chosen, the CPU activates the camera 16 to image the user and the colored backdrop 112" Col. 8 Lines 25-27 and "CPU generates a multiple image file... for printing on a single sheet" Col. 8 Lines 47-49 and "CPU sends the multiple image file to the printer... printer prints the transmitted image file to a single sheet of multiple peel-off sticker material." Col. 8 Lines 49-53; system performs this operation with layers in a fixed order, user image layer 1 on backdrop/background layer 2);

selection means {a selection step}("numbered windows" Col. 4 Line 12) for selecting one of a plurality of background patterns (sixteen different background patterns" Col. 8 Line 15) displayed on a display screen by using the touch panel ("numbered windows" on monitor 14 "in the form of a touch display" Col. 4 Lines 19-23);

background image display means {a background image display step}("software program that controls the process of the system" Col. 3 Lines 53-54) for displaying on the display screen a background image corresponding to the background pattern selected by said selection means (When the window of choice is selected ... users see themselves on the full screen with the selected background color." Col. 4 Lines 24-28) and storing the background image as a bitmap image ("electronic digital image" Col. 4 Line 49 and "digitized information" Col. 8 Line 47) in a layer ("layer" Col. 8 Line 32) corresponding to a background image layer ("layer 2" Col. 8 Line 32) among the plurality of logical layers in said storage means;

control means {a control step}("CPU" 21 Col. 2 Line 41) for generating a set of bitmap image data corresponding to an inputted character string and storing the bitmap

image in a layer assigned to the inputted character string among the plurality of logical layers of said storage means, each time a character string is inputted by said input means (system is capable of performing this function as additional fixed layers are explicitly disclosed by Attenberg, e.g. "foreground image" Col. 8 Line 36).

generating means {a generating step} ("CPU" 21 Col. 8 Line 25) for generating image data of a sticker {to be printed} by laying out each of the stored sets of bitmap image data stored in said storage means in accordance with said fixed order and predetermined positions assigned to each of the logical layers ("This is accomplished by defining the user as one layer (layer 1) and the backdrop color as another layer (layer 2), and substituting the selected background image for layer 2. At step S96, a user may optionally also select a foreground image from a number of displayed foregrounds, and at step S97, the CPU overlays the selected foreground image with the composited live image of the user and the selected background. Col. 8 Lines 30-39);

edit means {an editing step} for, when a desired layer to be edited is designated by using said touch panel with regard to image data obtained by said generating means {using said input means}, editing the designated layer, re-generating image data {to be printed} of the sticker by overlaying bitmap image data of the edited layer and bitmap image data of non-edited layers in accordance with said fixed order and the positions assigned to each of the logical layers ("At step S98, a countdown is begun to allow the user a period of time during which to adjust his/her pose, facial expression, and image orientation, before an image is "frozen." At step S99, the image on the display is captured or frozen by the CPU, either as a result of a timeout in step S98 or in response

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to the actuation of an image freeze button by the user. At step S100, the CPU saves the captured image as digitized information. At step S101, the CPU generates a multiple image file from the saved captured image, for printing on a single sheet.." Col. 8 Lines 40-49); and

output means {an output step} for, when an output instruction is inputted by using said touch panel, outputting the image data of the sticker, obtained by said generating means or said edit means, to printing means ("At S102, the CPU sends the multiple image file to the printer, which is received by the printer at step S103. Next, at S104 the printer prints the transmitted multiple image file to a single sheet of multiple peel off sticker material." Col. 8 Lines 49-55).

Attenberg discloses of a plurality of logical layers (background, user image, and foreground). However, Attenberg fails to teach of input means {an input step} for inputting, by using the touch panel, a plurality of character strings to be printed on a sticker, each of said character strings being assigned to each of the plurality of logical layers.

Frey teaches of an input means for inputting, by using the touch panel ("touch screen" 213 Col. 4 Line 22-23), a plurality of character strings to be printed on a sticker, each of said character strings being assigned to each of the plurality of logical layers ("banners" Col. 4 Lines 1-32 and "text message" Col. 5 Lines 1-9; "The cpu uses standard software programs that are known in the art field to combine the electronic image captured by the camera, the optional superimposed banner, the optional audio

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message, and the optional text message into electronic files." Col. 5 Lines 58-62) in order to provide an improved interactive photo kiosk (Col. 2 Line 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the character strings integrated onto electric images as taught by Frey into the teachings of Attenberg in order to provide an improved interactive photo kiosk.

In Reference to Claims 19 and 20

Attenberg discloses an apparatus substantially equivalent to that of applicant's claimed invention. However, Attenberg fails to disclose input means comprising means for displaying predetermined sample character strings on the display screen; means for selecting a character string from the displayed sample character strings by using the touch panel; means for setting the touch panel as character input means; means for displaying a virtual keyboard for character input operation when the touch panel is set as character input means; and means for setting a character design

Frye teaches of input means comprising means for displaying predetermined sample character strings on the display screen; means for selecting a character string from the displayed sample character strings by using the touch panel; means for setting the touch panel as character input means; means for displaying a virtual keyboard for character input operation when the touch panel is set as character input means (Col. 4 Lines 1-32), and means for setting a character design ("After the user inputs the information, the cpu saves the electronic files onto the user's removable electronic

storage device under the given name, 237. In such a manner, the user can save the audio, text, and video images as an electronic file for future retrieval and usage.” (Col. 5 Lines 20-25) in order to provide an improved interactive photo kiosk (Col. 2 Line 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the means as taught by Frey into the teachings of Attenberg in order to provide an improved interactive photo kiosk (Col. 2 Line 30).

In Reference to Claims 21 - 23

Attenberg as modified by Frey discloses an apparatus substantially equivalent to that of applicant’s claimed invention wherein the sticker has a form corresponding to a senjafuda, the form consisting of a header, a main body, and an insertion portion (system is capable of performing this function; each fixed layer of Attenberg as modified by the character strings of Frey); and wherein said input means inputs respective character strings for the header, main body, and insertion portion (system is capable of performing this function); wherein said printing means prints plural stickers on one sheet (Fig. 5); and further comprising setting means for setting whether or not to insert the insertion portion into the form (system is capable of performing this function; “having a banner added to an image or no banner added to the image” Col. 4 Lines 3-4), wherein in a case that the setting means sets to insert the insertion portion into the form, a part of the stickers in one sheet are printed with the insertion portion inserted into the form (system is capable of performing this function).

In Reference to Claim 24

Attenberg as modified by Frey discloses an apparatus further comprising memory means for storing data inputted by said input means ("memory" 21a); and designation means ("image processing program" Col. 7 Lines 56-56 and "freeze capture function" Col. 7 Line 61) for designating to return to an input subject for changing already-inputted data, wherein in a case where said designation means designates to return to an input subject, contents stored in said memory means are used as a default setting of the input subject (system is capable of performing this function ("The modified image data is then sent to the monitor 14 for viewing by the user. According to this embodiment, the user may adjust the image appearance after activating the image freeze capture function which causes the instantaneous image data from the camera 16 to be sent to the CPU and stored in memory)).

3. Claims 32 and 37 - 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,913,019 to Attenberg (Attenberg) of record in view of U.S. Patent No. 6,369,908 to Frey et al. (Frey) of record and further in view of U.S. Patent No. 5,930,810 to Farros et al. (Farros).

In Reference to Claim 32

Attenberg as modified by Frey disclose an apparatus substantially equivalent to applicant's claimed invention. However, Attenberg as modified by Frey fail to disclose

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an apparatus wherein the sets of image data obtained by said generating means are each arranged at predetermined fixed positions on the background image.

Farros teaches of sets of image data are each arranged at predetermined fixed positions on the background image (Fig. 7 and "The "Positions of objects" block 721 allows the changing of the position of an object, within predefined limits on the form." Col. 9 Lines 6-7) in order for laypersons to make aesthetically pleasing high quality printed products (Col. 3 Lines 7-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the invention as taught by Farros into the teachings of Attenberg in order for laypersons to make aesthetically pleasing high quality printed products.

In Reference to Claim 37

Attenberg discloses a printing apparatus (Fig. 1 "photo kiosk" 10) for printing an image on a desired sheet ("sticker sheet" Col. 5 Lines 26-27 and Fig. 5), comprising:

storing control means ("CPU saves the captured image" Col. 8 Line 46 and "stored in memory 21a associated with CPU 21" Col. 7 Line 49) for storing, in a predetermined storage ("user as one layer 'layer 1' and backdrop color/background image as another layer 'layer 2'" Col. 8 Lines 31-32), the character and the image ("image from camera 16" Col. 7 Lines 48 and "background image" Col. 8 Line 21), as each one of a plurality of logical layers ("Once the background image is chosen, the CPU activates the camera 16 to image the user and the colored backdrop 112" Col. 8

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Lines 25-27 and "CPU generates a multiple image file... for printing on a single sheet"
Col. 8 Lines 47-49 and "CPU sends the multiple image file to the printer... printer prints
the transmitted image file to a single sheet of multiple peel-off sticker material." Col. 8
Lines 49-53; system performs this operation with layers in a fixed order, user image
layer 1 on backdrop/background layer 2), inputted by said input means;

edit means for, when a desired layer to be edited is designated, editing the
designated layer ("At step S98, a countdown is begun to allow the user a period of time
during which to adjust his/her pose, facial expression, and image orientation, before an
image is "frozen." At step S99, the image on the display is captured or frozen by the
CPU, either as a result of a timeout in step S98 or in response to the actuation of an
image freeze button by the user. At step S100, the CPU saves the captured image as
digitized information. At step S101, the CPU generates a multiple image file from the
saved captured image, for printing on a single sheet.." Col. 8 Lines 40-49); and

layout means ("CPU" 21 Col. 8 Line 25) for laying out each of the stored
character and image read from each of plurality of logical layers in accordance with a
fixed order ("This is accomplished by defining the user as one layer (layer 1) and the
backdrop color as another layer (layer 2), and substituting the selected background
image for layer 2. At step S96, a user may optionally also select a foreground image
from a number of displayed foregrounds, and at step S97, the CPU overlays the
selected foreground image with the composited live image of the user and the selected
background. Col. 8 Lines 30-39).

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Attenberg discloses of a plurality of logical layers (background, user image, and foreground). However, Attenberg fails to teach of input means for entering a character and an image which are parts for forming an output image.

Frey teaches of an input means for entering a character and an image which are parts for forming an output image ("touch screen" 213 Col. 4 Line 22-23; adding "banners" Col. 4 Lines 1-32 and "text message" Col. 5 Lines 1-9; "The cpu uses standard software programs that are known in the art field to combine the electronic image captured by the camera, the optional superimposed banner, the optional audio message, and the optional text message into electronic files." Col. 5 Lines 58-62) in order to provide an improved interactive photo kiosk (Col. 2 Line 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the character strings integrated onto electric images as taught by Frey into the teachings of Attenberg in order to provide an improved interactive photo kiosk.

Attenberg as modified by Frey disclose an apparatus substantially equivalent to applicant's claimed invention. However, Attenberg as modified by Frey fail to disclose an apparatus wherein said layout means comprises rotation means for rotating an image of a layer.

Farros teaches of sets of image data which are each arranged at predetermined fixed positions on the background image (Fig. 7 and "The "Positions of objects" block 721 allows the changing of the position of an object, within predefined limits on the

form." Col. 9 Lines 6-7) in order for laypersons to make aesthetically pleasing high quality printed products (Col. 3 Lines 7-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the invention as taught by Farros into the teachings of Attenberg in order for laypersons to make aesthetically pleasing high quality printed products.

In Reference to Claims 38 - 39

Attenberg discloses a printing means for, when an output instruction is inputted by using said input means, printing image data obtained by said layout means ("At S102, the CPU sends the multiple image file to the printer, which is received by the printer at step S103. Next, at S104 the printer prints the transmitted multiple image file to a single sheet of multiple peel off sticker material." Col. 8 Lines 49-55).and selection means ("numbered windows" Col. 4 Line 12) for selecting layers to be outputted (sixteen different background patterns" Col. 8 Line 15), wherein said layout means lays out images of the layers selected by said selection means ("numbered windows" on monitor 14 "in the form of a touch display" Col. 4 Lines 19-23).

Response to Arguments

4. Applicant's arguments filed 8/8/2006 have been fully considered but they are not persuasive. The applicant argues that not all of the claimed features of Claim 17 are in Attenberg, namely, generating a character string and laying out the images of the layers

in a fixed order. Examiner agrees with the applicant. These features are absent from Attenberg. However, applicant received a rejection under 35 U.S.C. § 103 not § 102. Under 35 U.S.C. § 103, the absent claim limitations are found in Frey of record. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the character strings integrated onto electric images as taught by Frey in order to provide an improved interactive photo kiosk.

5. The applicant argues that not all of the claimed features of Claim 37 are in Attenberg, of note, inputting a character and layout means comprising rotating means for rotating an image of a layer. Examiner agrees with the applicant. These features are absent from Attenberg. However, applicant received a rejection under 35 U.S.C. § 103 not § 102. Under 35 U.S.C. § 103, the absent claim limitations are found in Frey of record further in view of Farros. Farros teaches of sets of image data which are each arranged at predetermined fixed positions but the image position can be changed, within predefined limits on the form. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the invention as taught by Farros into the teachings of Attenberg as modified by Frey in order for laypersons to make aesthetically pleasing high quality printed products.

6. The applicant argues that even if Drake (not relied upon in this action) and Frey are deemed to show all that they are cited for, the result of the proposed combination of those two patents with Attenberg, would not meet the terms of each of Claims 17 and 37. Examiner respectfully disagrees with the applicant. Attenberg provides several claim limitations to include storage means, selection means, background image display

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means, control means, generating means, edit means, and output means. Frey teaches of an input means for inputting, by using the touch panel ("touch screen" 213 Col. 4 Line 22-23), a plurality of character strings to be printed on a sticker, each of said character strings being assigned to each of the plurality of logical layers ("banners" Col. 4 Lines 1-32 and "text message" Col. 5 Lines 1-9; "The cpu uses standard software programs that are known in the art field to combine the electronic image captured by the camera, the optional superimposed banner, the optional audio message, and the optional text message into electronic files." Col. 5 Lines 58-62) in order to provide an improved interactive photo kiosk (Col. 2 Line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the character strings integrated onto electric images as taught by Frey into the teachings of Attenberg in order to provide an improved interactive photo kiosk. Further, Farros teaches of sets of image data are each arranged at predetermined fixed positions on the background image (Fig. 7 and "The "Positions of objects" block 721 allows the changing of the position of an object, within predefined limits on the form." Col. 9 Lines 6-7) in order for laypersons to make aesthetically pleasing high quality printed products (Col. 3 Lines 7-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the invention as taught by Farros into the teachings of Attenberg as modified by Frey in order for laypersons to make aesthetically pleasing high quality printed products.

7. The applicant argues that other independent claims recites features that are similar in many relevant respects to those of Claim 17 and each such independent claim

is accordingly deemed allowable for at least the reasons presented in the remarks. Applicant further argues that a review of the art of record fails to reveal anything which would remedy the deficiencies of the art discussed in applicant's remarks, as references against the independent and dependent claims. Examiner respectfully disagrees with the applicant. Applicant has not provided an argument but a conclusory statement of patentability. Examiner has provided a detailed mapping and analysis of each claim limitation for all independent and independent claims in support of the claim rejections that will not be repeated here for brevity. For the reasons provided above the rejections are maintained by the Examiner.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,116,906 to Rifkin discloses a method for producing stickers for toys.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571) 270-1992. The examiner can be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

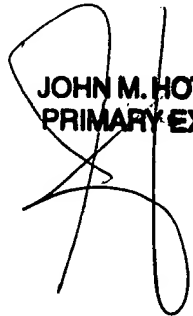
you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P. D'Agostino
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JOHN M. HOTALING, II
PRIMARY EXAMINER